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|----------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| APPLICATION NO.                                                                              | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/053,788                                                                                   | 01/18/2002  | Motoi Sato           | 13700-269115        | 4278             |
| 23370                                                                                        | 7590        | 03/23/2009           |                     |                  |
| JOHN S. PRATT, ESQ<br>KILPATRICK STOCKTON, LLP<br>1100 PEACHTREE STREET<br>ATLANTA, GA 30309 |             |                      | EXAMINER            |                  |
|                                                                                              |             |                      | DURAN, ARTHUR D     |                  |
|                                                                                              |             |                      | ART UNIT            | PAPER NUMBER     |
|                                                                                              |             |                      | 3622                |                  |
|                                                                                              |             |                      | MAIL DATE           | DELIVERY MODE    |
|                                                                                              |             |                      | 03/23/2009          | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                    |
|------------------------------|--------------------------------------|------------------------------------|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/053,788 | <b>Applicant(s)</b><br>SATO ET AL. |
|                              | <b>Examiner</b><br>Arthur Duran      | <b>Art Unit</b><br>3622            |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 January 2009.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5,7-13 and 15-18 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - 5) Claim(s) \_\_\_\_\_ is/are allowed.
  - 6) Claim(s) 1-5, 7-13, and 15-18 is/are rejected.
  - 7) Claim(s) \_\_\_\_\_ is/are objected to.
  - 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Claims 1-5, 7-13, and 15-18 have been examined.

### ***Response to Amendment***

2. The Remarks filed on 1/2/09 are sufficient to overcome the prior rejection.

However, a new reference has been added to the 35 USC 103 rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7-13, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greening (2001/0013009) in view of Linden (20050102202)

Claims 1, 9, 17, 18: Greening discloses a recommended item presentation method, comprising the steps of:

(a) obtaining client identifier associated client preference estimating factor information of a plurality of clients which is information according to which a preference of each client is to be estimated; and

(b) receiving a recommended item presentation request and a client preference estimating factor information of one client from an item provider server for providing

items to a plurality of clients through a network, where the client preference estimating factor information indicates a preference of the one client, producing a recommended item list according to the client identifier associated client preference estimating factor information and the client preference estimating factor information, and transmitting the recommended item list to the item provider server (Abstract; Figures 1, 2, 4, 6, 7, 11).

Additionally, note that Applicant's own Specification states that many of the features of the Applicant's claims are obvious, old and well known (Sato, Figures 14 and 15; Paragraphs [1-25]). Also, in the Applicant's Remarks dated 9/20/2007 on page 11, Applicant states that Greening discloses, "Greening discloses a system that predicts the interest of a user in specific items, by directly using information which identifies each client and is directly obtained from each client, similar to (1) described above."

Also, Greening further discloses, regarding particular items accessed by the one client. . . by using the client preference estimating factor information as a key for obtaining related clients and related items from the client identifier associated client preference estimating factor information, and transmitting (Figures 1, 3, 4).

Greening further discloses receiving a request from an item provider server ([50, 126]).

Additionally, the prior art renders obvious these features: a client requests item recommendations, an item server is provided client preferences but is not provided any client identifier. A recommendation server is provided the client preferences. The recommendation server then takes the client preferences and matches the client preferences to a list of many client id's and many client preferences that the

recommendation server already has. The recommendation server then recommends a product list based on how the unidentified client with preferences matches up with the database of many identified clients with preferences.

Greening discloses that a client requests items (Fig. 4, item 109), and an item server is provided client preferences (Fig. 1). Greening further discloses a recommendation server is provided preferences of many clients (Fig. 1). The recommendation server then takes the preferences and matches the preferences to a list of client id and preference that the recommendation server already has (Fig. 1; Fig. 3). The recommendation server then recommends a product list based on how the client with preferences matches up with the database of identified clients with preferences (Fig. 1).

Greening does not explicitly disclose that the item server or recommendation server is not provided a client identifier of the individual client for the matching. Greening does disclose that an identified client with preferences is matched to many identified clients with preferences (Fig. 1). Greening does not explicitly disclose that the recommendation server matches an unidentified client with preferences to many identified clients with preferences.

However, Linden discloses matching the preferences of an individual unidentified client with the preferences of many identified clients so that items can be recommended (Fig. 7, 3, 1; claims 1, 13, 23, 34; [9, 19, 199]).

Also, Linden further discloses these features: a client requests item recommendations (Fig. 7), an item server is provided client preferences but is not

provided any client identifier (Fig. 7). A recommendation server is provided the client preferences. The recommendation server then takes the client preferences and matches the client preferences to a list of many client id's and many client preferences that the recommendation server already has (Fig. 3, 1). The recommendation server then recommends a product list based on how the unidentified client with preferences matches up with the database of many identified clients with preferences (Fig. 7, 3, 1).

Also, Linden further discloses a request identifier (Fig. 3b, item 300; Figures 8, 9).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Linden's matching an unidentified client's preferences to Greening's matching a client's preferences with many identified client's preferences. One would have been motivated to do this in order to better protect user privacy or better allow targeting of new users.

Greening further discloses that the step also processes the client identifier associated client preference estimating factor information into a client preference estimating factor information map and the step produces the recommended item list according to the client preference estimating factor information map and the client preference estimating factor information (Abstract; Figures 11, 3, 1, 2, 4, 6, 7). Also, Linden further discloses a map of preferences to items ([16, 17, 18, 54, 55]).

Claim 2, 10: The combination of the prior art discloses the above. Greening further discloses that the step (a) obtains the client identifier associated client preference estimating factor information by receiving a client preference estimating

factor information list from a client preference estimating factor information list providing server which collects the client identifier associated client preference estimating factor information from a plurality of clients (Abstract, [15]).

Claims 3, 11: The combination of the prior art discloses the above. Greening further discloses that the step (a) receives the client identifier associated client preference estimating factor information list in a form of a list of item identifiers of viewed/purchased items at the item provider server and dates and times of viewings/purchases of the viewed/purchased items for each client identifier, or a list of item identifiers of viewed/purchased items at the item provider server and ratings indicating levels of interest of each client with respect to the viewed/purchased items for each client identifier, or a list of item identifiers of interested items of each client for each client identifier (Abstract, [15]).

Claim 4, 5, 12, 13: The combination of the prior art discloses the above. Greening does not explicitly disclose the step of paying a fee for transmission of the client identifier associated client preference estimating factor information list to the client preference estimating factor information list providing server.

Greening does not explicitly disclose the step of receiving a fee for transmission of the recommended item list from the item provider server.

However, Sato (Applicant's Own Specification) states that it is obvious, old and well known that fees can be charged for advertising, recommendations, or other provided services (Sato, [22]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was that a fee can be charged for providing relevant information. One would have been motivated to do this in order to better provide a source of revenue.

Claims 7, 15: The combination of the prior art discloses the above. Greening further discloses that the step (a) produces the client preference estimating factor information map in a form of any of a list of item identifiers of accessed items of each client for each client identifier, a list of item identifiers of accessed items of each client and ratings indicating levels of interest of each client with respect to the accessed items for each client identifier, a list of client identifiers of accessing clients of each item for each item identifier, a list of client identifiers of accessing clients of each item and ratings indicating levels of interest of each client with respect to each item for each item identifier, and a list of correlation values among correlated items (Abstract; Figures 11, 3, 1, 2, 4, 6, 7).

Claims 8, 16: The combination of the prior art discloses the above. Greening further discloses that the step (b) produces the recommended item list by: obtaining a related client list by extracting client identifiers contained in a list of client identifiers for each item that constitutes the client preference estimating factor information map, for each item identifier in a list of item identifiers that constitutes the client preference estimating factor information received along with the recommended item presentation request from the item provider server; narrowing

down the related client list by extracting item identifiers contained in a list of item identifiers for each client that constitutes the client preference estimating factor information map, for each client identifier in, the related client list, counting a number of overlaps between extracted item identifiers and item identifiers in the list of item identifiers that constitutes the client preference estimating factor information, for each client identifier in the related client list, rearranging client identifiers in the related client list in a descending order of counted number of overlaps, and setting a first prescribed number of client identifiers from a top of a rearranged related client list as a new related client list; obtaining a related item list by extracting item identifiers contained in the list of item identifiers for each client, for each client identifier in the new related client list; and narrowing down the related item list by extracting client identifiers contained in the list of client identifiers for each item, for each item identifier in the related item list, counting a number of overlaps between extracted client identifiers and client identifiers in the new related client list, for each item identifier in the related item list, rearranging item identifiers in the related item list in a descending order of counted number of overlaps, and setting a second prescribed number of item identifiers from a top of a rearranged related item list as the recommended item list (Greening, Figures 1, 4-11; [18, 42, 43, 45, 68, 69]).

***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the grounds of rejection above. Please see the 35 USC 103 rejection above using Greening in view of Linden. Please note the addition of the Linden reference.

***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

aa) Jacobi (US006317722B1) discloses recommendations to a new, unknown shopper; Finseth (US 20050028207A1) discloses relevant features for anonymous recommendations ([81, 84, 95]); ;Kent (US 20020040374A1) discloses relevant features for anonymous recommendations ([71]); Meidan (20020065797A1) discloses relevant features for anonymous recommendations; Engberg discloses recommendations to an anonymous user ([29, 194]); as does Linden ([199]); as does Goldstein ([55, 57], claims 6, 7);

a) Bieganski (6,321,221), Lokuge (5,907,836), Sumita (5,907,836) disclose recommendation inventions with relevant features;

b) Dedrick (5,724,521) and Goldhaber (5,794,210) disclose charging for information providing and protecting user privacy.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Arthur Duran  
Primary Examiner  
Art Unit 3622

/Arthur Duran/  
Primary Examiner, Art Unit 3622  
3/19/2009